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Formal Submission: REPLY BRIEF	09/651,548

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NOTES/COMMENTS:

1. Reply Brief

Respectfully submitted,

B. Russell/vf

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:
ATKINS ET AL.

Serial No.: 09/651,548

Filed: **AUGUST 29, 2000**

Title: SYSTEM, METHOD AND PROGRAM FOR MANAGING A USER KEY USED TO SIGN A MESSAGE FOR A DATA PROCESSING SYSTEM

Attorney Docket No.: RPS920000026US1

Examiner: **SHIN, KYUNG H.**

Group Art Unit: 2143

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted in response to the Examiner's Answer dated January 26, 2006, having a two-month period of response.

CERTIFICATE OF FACSIMILE
37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the United States Patent and Trademark Office on the below listed date by facsimile transmission to (571) 273-8300.

Date: 3/21/06

By: Vicki K. Kowalsky
Signature

REMARKS

I. Exemplary Claim 1 is not rendered unpatentable by *Doonan* and *Sudia*

In Appellants' Appeal Brief dated November 1, 2005, Appellants demonstrated that exemplary Claim 1 is not rendered unpatentable under 35 U.S.C. § 103 by the combination of U.S. Patent No. 6,807,277 to *Doonan* and U.S. Patent No. 6,009,177 to *Sudia* because that combination of references does not disclose "thereafter, preventing validation of the association of the user with messages by revoking the associated key at the encrypting data processing system," as recited in Claim 1. Instead, the combination of *Doonan* and *Sudia* discloses conventional revocation of a user public key by publication of the user's certificate on a certifying authority's certificate revocation list (CRL).

In response to Appellants' arguments and in apparent recognition of the deficiency in the Final Rejection, the Examiner at page 12 of the Examiner's Answer makes two arguments with respect to Claim 1. First, the Examiner attempts to buttress the § 103 rejection by alluding to prior art (viz. U.S. Patent No. 6,732,101 to *Cook*) not previously relied upon in the rejection of Claim 1. As is made clear in MPEP 1207.03, while the Examiner in rare circumstances is permitted to enter a new ground of rejection in the Examiner's Answer, such is only the case where the new ground of rejection is:

- (A) approved by a Technology Center (TC) Director or designee; and
- (B) prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section and the "Grounds of Rejection" section of the answer ... [MPEP § 1207.03].

Because the Examiner has failed to follow the requirements to enter a new ground of rejection including *Cook*, *Cook* may not properly be relied upon by the Examiner in an attempt to address the defects in the rejection under 35 U.S.C. § 103 in view of *Doonan* and *Sudia*.

Second, the Examiner, at page 12 of the Examiner's Answer, responds to Appellants' arguments set forth in the Appeal Brief by stating:

Sudia features combined with *Doonan* features create one server with the entire set of features. Therefore, the revoke feature is performed at the same data processing system as encryption (i.e., at the encrypting data processing system).

Appellants respectfully traverse the Examiner's conclusion because both *Doonan* and *Sudia* clearly teach three computer system participants in the encrypted communication systems disclosed therein rather than "one server with the entire set of features" as urged by the Examiner.

In particular, Figures 1 and 2 of *Doonan* clearly disclose a secure messaging system including a sender 100, a recipient 102 and a key server 106. Similarly, col. 21, line 15 through col. 23, line 2 of *Sudia* disclose a cryptographic system including a sender, a recipient and a certifying authority that manages public key certificates. The Examiner has not indicated how or why a person of ordinary skill in the art would be motivated by the reference teachings to merge multiple ones of these independent systems to obtain "one server with the entire set of features" as urged by the Examiner. Without such objective motivation, the Examiner may not properly modify the clear teaching of the references that a key is revoked by publishing the associated certificate on a CRL at the certifying authority in an attempt to render obvious the claimed step of revoking the key at the encrypting data processing system (i.e., the sender).

In view of the failure of *Doonan* and *Sudia* to disclose each feature of exemplary Claim 1 as required for a rejection under 35 U.S.C. § 103, Appellants respectfully request the Board to reverse the rejections of Claim 1, similar Claims 9 and 17 and their respective dependent claims.

II. Exemplary Claim 7 is not rendered unpatentable by *Doonan* and *Sudia*

In Appellants' Appeal Brief dated November 1, 2005, Appellants demonstrated that the Examiner has failed to establish a *prima facie* case of obviousness with respect to exemplary Claim 7 (and similar Claims 15 and 23) by failing to provide evidence that the cited combination of U.S. Patent No. 6,807,277 to *Doonan* and U.S. Patent No. 6,009,177 to *Sudia* discloses "communicating an encrypted associated key to validate the association of the user with the encrypted messages," as claimed.

In response to Appellants' argument, the Examiner argues at page 12 of the Examiner's Answer that col. 2, lines 7-10 (and similarly lines 57-61) of *Doonan* disclose:

The sender uses the encryption key to encrypt the message contents. The sender then transmits the message and the key retrieval information to the intended recipient using the existing mail infrastructure.

The Examiner then argues, "Key retrieval information is analogous to the association key information [sic], which is used to retrieve and access the user key."

In response, Appellants note that Claim 7 does not recite "association key information" as discussed by the Examiner, but instead recites "an encrypted associated key." Moreover, the test for obviousness is not analogy between an element in the references and a claim element as posited by the Examiner, but rather whether the reference(s) teach or suggest each claim element set forth in the claim. In the present case, it is apparent that the Examiner's Answer does not remedy the deficiency pointed out by Appellants, namely, that the Examiner's combination of *Doonan* and *Sudia* does not teach or suggest the "communicating an encrypted associated key to validate the association of the user with the encrypted messages." Consequently, Claim 7 and similar Claims 15 and 23 are not rendered unpatentable under 35 U.S.C. § 103 by the Examiner's combination of references.

III. Conclusion

In view of the foregoing arguments, Appellants respectfully request reversal of the rejection of each pending claim.

No additional fee is believed to be required. If, however, any additional fees are required, please charge those fees to Lenovo Inc. Deposit Account No. 50-3533.

Respectfully submitted,



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